PTAB Highlights | Takeaways From Recent Decisions in Post-Issuance Proceedings

By Katie Becker and Emily M. Ross[i]

Additional discovery requests, design patent obviousness and secondary considerations are a few of the topics covered in Banner Witcoff's latest installment of PTAB Highlights.

Institution Denied Under § 325(d) Due to Cumulative Art. In denying institution of the petition, the PTAB found that a physicians' desk reference, which had not been previously considered by the Office during prosecution or institution of a prior IPR, was considered cumulative because its disclosures were taught by the prior IPR's secondary references and petitioner characterized the prior IPR as having been "instituted based on the cited prior art and similar arguments." Glaxosmithkline Consumer Healthcare Holdings (US) LLC v. Cipla Ltd., IPR2020-00368, Paper 7 (July 31, 2020) (Yang, joined by Kokoski and Kaiser).

Design Patent Obviousness. On remand, the Board found that the petitioner failed to demonstrate by a preponderance of the evidence that the challenged claim of a design patent was unpatentable under 35 U.S.C. § 103 in view of the strong presented evidence of objective indicia of nonobviousness. The Board relied on presented evidence of commercial success and copying by the petitioner to reach the conclusion that it was not shown to have been obvious to modify the primary reference to arrive at the patented design for a gravity feed dispenser display. Campbell Soup Co. v. Gamon Plus, Inc., IPR2017-00091, Paper 113 (July 29, 2020) (Kinder, joined by Obermann and Gerstenblith).

Discovery Request for Prototypes. In denying patent owner's motion for additional discovery, the Board found that the petitioner was not required to produce certain golf clubs and parts referred to in expert exhibits because the PTAB's limitation of the admissibility of those exhibits alleviated

the prejudice that patent owner's request for additional discovery sought to address, and patent owner had not presented a persuasive argument why petitioner should bear the burden and expense of creating prototypes when patent owner was not precluded from doing so itself, and petitioner offered to make the clubs available for inspection. Club Champion LLC v. True Spec Golf LLC, IPR2019-01148, Paper 49 (July 2, 2020) (Moore, joined by Scanlon and Cherry).

Additional RPI Discovery. Denying motion for additional discovery relevant to whether petitioner's real parties in interest were appropriately identified, the PTAB found that at the time, the patent owner's allegations regarding the real parties in interest were "merely speculative" thereby not warranting the requested discovery. Commscope Technologies LLC v. Barkan Wireless IP Holdings, L.P., IPR2020-00827, 829, 838, 831, 835, Paper 6 (Aug. 3, 2020) (Saindon joined by Dang, Petravick, Saindon, Engels, and Hudalla)

No Advisory Opinions. The Board denied institution of inter partes review of any challenged claim under 35 U.S.C. § 314(a) because the petition improperly sought an advisory opinion on the indefiniteness of the claims directed to a plurality of stations capable of forming an ad-hoc radio communications network. In particular, petitioner invited the Board to adopt its proposed constructions, or determine which one(s) of the mean-plus-function limitations of the challenged claims may be possibly indefinite, but the Board declined to take a position on both issues. Google v. Uniloc 2017 LLC, IPR2020-00397, Paper 11 (Aug. 3, 2020) (Droesch joined by McKone and McShane).

Secondary Considerations. In ruling the challenged claims of a patent directed to a nasally administered pharmaceutical solution of benzodiazepines unpatentable, the Board analyzed objective evidence of non-obviousness presented by the patent owner, finding the evidence of failure of others and long-felt need unpersuasive in view of (1) patent owner failing to allege any nexus with respect to the claimed formulation and these secondary considerations factors, and (2) evidence presented by the petitioner that the benzodiazepines were delivered nasally prior to the filing date of the patent. Aquestive Therapeutics, Inc. v. Neurelis, Inc., IPR2019-00451, Paper 44 (Aug. 6, 2020) (Wisz, joined by Yang and Tornquist).

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